

REMARKS

Claims 1-27 are pending in the present application. Claims 1, 3, 11 and 23 have been amended herein. The Specification and Drawings have been amended to correct several errors. Entry of this Amendment and further examination of the application in view of the amendments and following remarks is hereby requested.

Information Disclosure Statement

The Office Action stated that the Information Disclosure Statement filed February 1, 2002, had missing or inaccurate information regarding the *Lawrence, et al.*, *Osborn, et al.*, and *Larkey, et al.*, references. Applicants submit that they have disclosed all available information to them regarding the specific publication dates of those references in compliance with their duty under 37 C.F.R. §1.56. Applicants assert that the references can be considered relevant art to the present application.

Oath/Declaration

The Office Action required a new oath or declaration in compliance with 37 C.F.R. §1.67(a). Applicants submit herewith a new Oath and Declaration, stating that the inventors believe that they are the original, first and sole inventors of the subject matter which is claimed and for which a patent is sought, and identifying the provisional application 60/238,566, filed on October 6, 2000, the priority of which is claimed in this application. Applicants therefore assert that basis for this objection has been removed.

Drawings

The Office Action objected to the Drawings and asserted that several errors appear in Figs. 1, 2A, 2C and 2D. The Office Action objected to Fig. 1, stating that items 130 and 140 are missing the names recited on Page 9, at Lines 6-7 of the Specification. Applicants traverse this objection. Fig. 1 correctly has reference numerals identifying each of the elements and adequately describes those elements in the Specification. Further, the Specification does not indicate that the names of those elements appear next to the illustrated elements in Fig. 1. Accordingly, because the elements are clearly identified in Fig. 1 by a reference numeral and are clearly described in the Specification, Applicants submit that Fig. 1 complies with 37 C.F.R. §1.84 and request that this objection be withdrawn.

The Office Action further objected to the arrow from step 215 in Fig. 2A not going directly to step 225 as stated in the Specification, and likewise objected to the arrow from step 245 in Fig. 2 not going directly to the circled A [on page reference A] as suggested in the Specification. The Applicants traverse this objection and asserts that the requested changes would improperly indicate separate entrances to the processes at step 225 and step 255 respectively. The process threads are correctly illustrated in the flowchart of Fig. 2A as rejoining prior to entrance of the process. Accordingly, Applicants submit that the process threads illustrated in the flowchart of Fig. 2A are correct and comply with 37 C.F.R. §1.84, and therefore, Applicants request that this objection be withdrawn.

The Office Action objected to a mismatch between Fig. 2A and its description in the Specification concerning the process flow from decision 230. Applicant has amended the Specification to correctly recite the process illustrated in Fig. 2A, and accordingly, amendment to Fig. 2A is not required. Applicants therefore submit that the grounds for this objection have been removed.

The Office Action further objected to errors in Fig. 2C at step [decision] 325, and in Fig. 2D at step [decision] 355. Applicants submit herewith a replacement sheet correcting errors in Figs. 2C and 2D, with a sheet showing the corrections to Figs. 2C and 2D shown in red. In view of such correction, Applicants submit that the grounds for this objection have been removed.

Objections to the Specification

The Office Action objected to the Specification as containing improper reference to trademarked terms, and for containing an embedded hyperlink. The Applicants have amended the Specification to correctly identify the trademarks, and have deleted the hyperlink reference. In view of these amendments, Applicants submit that the grounds for this objection have been removed.

Claim Objections

The Office Action objected to Claims 1 and 3 as each having a typographical error. Applicants have amended Claims 1 and 3 above to correct the noted

typographical errors, and in view thereof, submit that the grounds for this objection have been removed.

Rejections under 35 U.S.C. §112, ¶2

Claims 11 and 23 were rejected under 35 U.S.C. §112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. Specifically, the Office Action stated that there was an element in Claim 11 that lacked a proper antecedent basis, and that Claim 23 improperly depended upon itself.

Applicants have amended Claim 11 to properly recite a listed element in Claim 5, and amended Claim 23 to depend upon Claim 22. In view of the amendments, Applicants submit that the grounds for these rejections have been removed and the rejections have been overcome.

Rejections under 35 U.S.C. §103

Claims 1-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Jain, et al.*, (US Patent No. 5,983,237, in view of *Rivette, et al.*, (US Patent No. 5,754,840), and in further view of *Doyle* (US Patent No. 6,009,455). Applicants traverse this rejection and request reconsideration thereof.

Claim 1

The Office Action stated that *Jain, et al.*, teaches all of the elements of Claim 1, except that *Jain, et al.*, did not teach generating a report based upon the search result set or transmitting the report to an output device. The Office Action further asserted that *Rivette, et al.*, teach the steps of generating a report based upon the search result set and transmitting the report to an output device, and then concluded that *Doyle* teaches storing the search result set in the data store. The Office Action stated that the motivation for the combination would be maximizing the diversity of results, verifying consistency of terminology within a document, and increasing productivity while tolerating failures. The Office Action then concluded it would have been obvious to one of skill in the art at the time the invention was made to combine the references to obtain the system of claim 1. Applicants traverse this ground of rejection and the characterization of the disclosure of the references.

Applicants firstly note that *Jain, et al.*, is for a "Visual Dictionary" that improves the retrieval performance of a query engine in a visual information retrieval system. See Abstract. *Jain, et al.*, defines "Visual Information Retrieval (VIR)" as "systems to extract and access the content of visual media, which include images and video. Col. 1, Lines 23-26. The system of *Jain, et al.*, improves a VIR "through a dictionary-like information mapping module, termed as visual dictionary or "victionary." Col. 6, Line 66-Col. 7, Line 3.

Conversely, the system of Claim 1 is for locating references related to a target mark, actual or potential, in one or more accessible information storage systems, and does not concern visual information retrieval. Therefore, *Jain, et al.*, is not analogous art to Claim 1 because one of skill in the art in searching for target marks would not look to the visual information retrieval system of *Jain, et al.*, to provide any search methodology, especially given the far different search criteria of each system. Consequently, *Jain, et al.*, is nonanalogous art under MPEP §2141.01(a) and cannot be considered as a reference available for combination under 35 U.S.C. §103.

Secondly, Applicants note that there has been shown no motivation to combine the references, *Jain, et al.*, *Rivette, et al.*, and *Doyle*, other than the motivation provided by the present application. The Office Action improperly uses the advantages of the present invention in searching for intellectual property as the motivation to combine the disparate references of a visual image searching system of *Jain, et al.*, the system for analyzing documents containing patent applications of *Rivette, et al.*, and the distributed computation system of networked computers of *Doyle*. It is improper to use the present application as the template to combine the references, and accordingly, this ground of rejection must fail.

Thirdly, the suggested combination does not disclose all elements of amended Claim 1. Under section 103, the suggested combination must teach or suggest all of the claim limitations. MPEP §2143. Here, the suggested combination does not disclose, at least, the step of receiving a target mark. Nowhere in any cited reference is disclosed the methodology or manner of searching for relevant art the intellectual property of a trademark. And the disclosure present application cannot be used to

supply this absent element. Therefore, as the suggested combination does not teach or disclose all limitations of amended Claim 1, this ground of rejection must fail and Applicants request withdrawal of the rejection and allowance of the claim.

In sum, the suggested combination of references cannot be used to reject amended Claim 1 under 35 U.S.C. §103. The suggest combination of references includes nonanalogous art, lacks proper motivation for combination, and does not disclose all elements of the rejected claim. Applicants respectfully request removal of this rejection and allowance of Claim 1.

Claim 2

The Office Action rejected Claim 2 for the reasons articulated for the rejection of Claim 1, and further stated that *Rivette, et al.*, discloses one or more storage elements comprised of at least one storage element that stores data on a removable media. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claim 1, Applicants assert that Claim 2 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 2.

Claim 3

The Office Action stated that *Jain, et al.*, teaches all of the elements of Claim 3, except that *Jain, et al.*, did not teach receiving a phase representing a limitation of a target claim, generating a report based upon the search result set, or transmitting the report to an output device. The Office Action further asserted that *Rivette, et al.*, teach the steps of receiving a phase representing a limitation of a target claim, generating a report based upon the search result set and transmitting the report to an output device, and then concluded that *Doyle* teaches storing the search result set in the data store. The Office Action stated that the motivation for the combination would be maximizing the diversity of results, verifying consistency of terminology within a document, and increasing productivity while tolerating failures. The Office Action then concluded it would have been obvious to one of skill in the art at the time the invention was made to combine the references to obtain the system of Claim 3. Applicants traverse this ground of rejection and the characterization of the disclosure of the references.

As argued above with respect to the patentability of Claim 1, Applicants note that *Jain, et al.*, is for a "Visual Dictionary" that improves the retrieval performance of a query engine in a visual information retrieval system. See Abstract. *Jain, et al.*, defines "Visual Information Retrieval (VIR)" as "systems to extract and access the content of visual media, which include images and video. Col. 1, Lines 23-26. The system of *Jain, et al.*, improves a VIR "through a dictionary-like information mapping module, termed as visual dictionary or "victionary." Col. 6, Line 66-Col. 7, Line 3.

Conversely, the system of Claim 3 is for locating references related to a target claim for a patent or potential patent application, and does not concern visual information retrieval. Therefore, *Jain, et al.*, is not analogous art to Claim 3 because one of skill in the art in searching for target claims would not look to the visual information retrieval system of *Jain, et al.*, to provide any search methodology, especially given the far different search criteria of each system. Consequently, *Jain, et al.*, is nonanalogous art under MPEP §2141.01(a) and cannot be considered as a reference available for combination under 35 U.S.C. §103.

Applicants further note that there has been shown no motivation to combine the references, *Jain, et al.*, *Rivette, et al.*, and *Doyle*, other than the motivation provided by the present application. The Office Action improperly uses the advantages of the present invention in searching for intellectual property as the motivation to combine the disparate references of a visual image searching system of *Jain, et al.*, the system for analyzing documents containing patent applications of *Rivette, et al.*, and the distributed computation system of networked computers of *Doyle*. It is improper to use the present application as the template to combine the references, and accordingly, this ground of rejection must fail.

Finally, the suggested combination does not disclose all elements of amended Claim 3. Under section 103, the suggested combination must teach or suggest all of the claim limitations. MPEP §2143. Here, the suggested combination does not disclose, at least, the step of creating an expanded search phrase. Nowhere in any cited reference is disclosed the methodology or manner of expanding claim terms. The assertion in the Office Action that *Jain, et al.*, in Figs. 4, 8-10C, discloses this step is

incorrect—all of the cited Figures (and *Jain, et al.*, itself) describes visual query parsing. Moreover, the system of *Rivette, et al.*, only concerns the development and maintenance of documents the require term consistency. Col. 2, Lines 18-30. *Rivette, et al.*, does not disclose or suggest the searching of external documents with one or more expanded search phrases. Therefore, as the suggested combination does not teach or disclose all limitations of amended Claim 3, this ground of rejection must fail and Applicants request withdrawal of the rejection and allowance of the claim.

In sum, the suggested combination of references cannot be used to reject amended Claim 3 under 35 U.S.C. §103. The suggest combination of references includes nonanalogous art, lacks proper motivation for combination, and does not disclose all elements of the rejected claim. Applicants respectfully request removal of this rejection and allowance of Claim 3.

Claim 4

The Office Action rejected Claim 4 for the reasons articulated for the rejection of Claim 3, and further stated that *Rivette, et al.*, discloses one or more storage elements comprised of at least one storage element that stores data on a removable media. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claim 3, Applicants assert that Claim 4 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 4.

Claim 5

The Office Action stated that *Jain, et al.*, teaches all of the elements of Claim 5, except that *Jain, et al.*, did not teach generating a report based upon the search result set, or transmitting the report to an output device. The Office Action further asserted that *Rivette, et al.*, teach the steps of receiving a phase representing a limitation of a target claim, and generating a report based upon the search result set and transmitting the report to an output device. The Office Action stated that the motivation for the combination would be maximizing the diversity of results and verifying consistency of terminology within a document. The Office Action then concluded it would have been obvious to one of skill in the art at the time the invention was made to combine the

references to obtain the system of Claim 5. Applicants traverse this ground of rejection and the characterization of the disclosure of the references.

As argued above with respect to the patentability of Claim 1, Applicants note that *Jain, et al.*, is for a "Visual Dictionary" that improves the retrieval performance of a query engine in a visual information retrieval system. See Abstract. *Jain, et al.*, defines "Visual Information Retrieval (VIR)" as "systems to extract and access the content of visual media, which include images and video. Col. 1, Lines 23-26. The system of *Jain, et al.*, improves a VIR "through a dictionary-like information mapping module, termed as visual dictionary or "victionary." Col. 6, Line 66-Col. 7, Line 3.

Conversely, the system of Claim 5 is for locating references related to a target intellectual property, and does not concern visual information retrieval. Therefore, *Jain, et al.*, is not analogous art to Claim 5 because one of skill in the art in searching for target items of intellectual property would not look to the visual information retrieval system of *Jain, et al.*, to provide any search methodology for intellectual property, especially given the far different search criteria of each system. Consequently, *Jain, et al.*, is nonanalogous art under MPEP §2141.01(a) and cannot be considered as a reference available for combination under 35 U.S.C. §103.

Applicants further note that there has been shown no motivation to combine the references, *Jain, et al.*, and *Rivette, et al.*, other than the motivation provided by the present application. The Office Action improperly uses the advantages of the present invention in searching for intellectual property as the motivation to combine the disparate references of a visual image searching system of *Jain, et al.*, and the system for analyzing documents containing patent applications of *Rivette, et al.* It is improper to use the present application as the template to combine the references, and accordingly, this ground of rejection must fail.

Finally, the suggested combination does not disclose all elements of Claim 5. Under section 103, the suggested combination must teach or suggest all of the claim limitations. MPEP §2143. Here, the suggested combination does not disclose, at least, the step of creating an expanded search phrase. Nowhere in any cited reference is disclosed the methodology or manner of expanding terms relative to a target

intellectually property item. The assertion in the Office Action that *Jain, et al.*, in Figs. 4, 8-10C, discloses this step is incorrect—all of the cited Figures (and *Jain, et al.*, itself) describes visual query parsing. Moreover, the system of *Rivette, et al.*, only concerns the development and maintenance of documents the require term consistency. Col. 2, Lines 18-30. *Rivette, et al.*, does not disclose or suggest the searching of external documents with one or more expanded search phrases. Therefore, as the suggested combination does not teach or disclose all limitations of Claim 5, this ground of rejection must fail and Applicants request withdrawal of the rejection and allowance of the claim.

In sum, the suggested combination of references cannot be used to reject Claim 5 under 35 U.S.C. §103. The suggest combination of references includes nonanalogous art, lacks proper motivation for combination, and does not disclose all elements of the rejected claim. Applicants respectfully request removal of this rejection and allowance of Claim 5.

Claim 6

The Office Action rejected Claim 6 for the reasons articulated for the rejection of Claim 5, and further stated that *Rivette, et al.*, discloses receiving a document selected from the group consisting of a patent, patent application, a trademark registration and a trademark registration application, and extracting the one or more search phrases from the received document. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claim 5, Applicants assert that Claim 6 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 6.

Claim 7

The Office Action rejected Claim 7 for the reasons articulated for the rejection of Claim 6, and further stated that *Rivette, et al.*, discloses receiving a reference to the document, and that *Doyle* disclosed transmitting a request for the document to an information storage system based upon the received reference. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.*, and *Doyle*. For the reasons discussed above with respect to the patentability of Claim 5, Applicants assert

that Claim 7 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 7.

Claim 8

The Office Action rejected Claim 8 for the reasons articulated for the rejection of Claim 1. For the reasons discussed above with respect to the patentability of Claim 1, Applicants assert that Claim 8 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 8.

Claim 9

The Office Action rejected Claim 2 for the reasons articulated for the rejection of Claim 1, and further stated that *Rivette, et al.*, discloses storing the generated report in a data store. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claim 1, Applicants assert that Claim 9 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 9.

Claim 10

The Office Action rejected Claim 10 for the reasons articulated for the rejection of Claim 1, and further stated that *Rivette, et al.*, discloses that the generated report comprises one or more fields that upon receipt by the output device allow a user to edit contents of the one or more fields, receiving one or more modification to the report corresponding to user input into the one or more fields, and modifying the report or search results based upon the received one or more modifications. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claim 1, Applicants assert that Claim 10 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 10.

Claim 11

The Office Action rejected Claim 11 for the reasons articulated for the rejection of Claim 10. For the reasons discussed above with respect to the patentability of Claims 1 and 10, Applicants assert that Claim 11 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 11.

Claim 12

The Office Action rejected Claim 12 for the reasons articulated for the rejection of Claim 1. For the reasons discussed above with respect to the patentability of Claim 1, Applicants assert that Claim 12 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 12.

Claim 13

The Office Action rejected Claim 13 for the reasons articulated for the rejection of Claim 12, and further stated that *Jain, et al.*, discloses calculating a correspondence value between each element of the search result set and each of the one or more descriptions, and sorting the elements of the search result set based upon the calculated correspondence values. Applicants traverse this rejection and characterization of the disclosure of *Jain, et al.* For the reasons discussed above with respect to the patentability of Claims 1 and 12, Applicants assert that Claim 13 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 13.

Claim 14

The Office Action rejected Claim 14 for the reasons articulated for the rejection of Claim 12, and further stated that *Rivette, et al.*, discloses calculating a correspondence value between each element of the search result set and the technical descriptions, and that *Jain, et al.*, discloses sorting the elements of the search result set based upon the calculated correspondence values. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.*, and *Jain, et al.* For the reasons discussed above with respect to the patentability of Claims 1 and 12, Applicants assert that Claim 14 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 14.

Claim 15

The Office Action rejected Claim 15 for the reasons articulated for the rejection of Claim 12, and further stated that *Rivette, et al.*, discloses calculating a frequency count associated with each element of the search result set, and that *Jain, et al.*, discloses sorting the elements of the search result set based upon the calculated frequency

count. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.*, and *Jain, et al.* For the reasons discussed above with respect to the patentability of Claims 1 and 12, Applicants assert that Claim 15 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 15.

Claim 16

The Office Action rejected Claim 16 for the reasons articulated for the rejection of Claim 15. For the reasons discussed above with respect to the patentability of Claims 1 and 15, Applicants assert that Claim 16 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 16.

Claim 17

The Office Action rejected Claim 17 for the reasons articulated for the rejection of Claim 15. For the reasons discussed above with respect to the patentability of Claims 1 and 15, Applicants assert that Claim 17 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 17.

Claim 18

The Office Action rejected Claim 18 for the reasons articulated for the rejection of Claim 1, and further stated that *Rivette, et al.*, discloses that the target item is a claim, and the receiving step comprises receiving a single search phrase comprising the mark. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claim 1, Applicants assert that Claim 18 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 18.

Claim 19

The Office Action rejected Claim 19 for the reasons articulated for the rejection of Claim 18. For the reasons discussed above with respect to the patentability of Claims 1 and 18, Applicants assert that Claim 19 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 19.

Claim 20

The Office Action rejected Claim 20 for the reasons articulated for the rejection of Claim 18, and further stated that *Jain, et al.*, discloses attempting to create additional

expanded search phrases by selectively parsing and regrouping the one or more search terms of the received single search phrase. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claims 1 and 18, Applicants assert that Claim 20 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 20.

Claim 21

The Office Action rejected Claim 21 for the reasons articulated for the rejection of Claim 1, and further stated that *Rivette, et al.*, discloses that the generated report is selected from the group consisting of a draft registerability analysis, draft infringement analysis, a draft Office Action, and a table of results. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claims 1 and 18, Applicants assert that Claim 21 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 21.

Claim 22

The Office Action rejected Claim 22 for the reasons articulated for the rejection of Claim 1, and further stated that *Rivette, et al.*, discloses that the target item is a claim, and receiving a search phrase corresponding to each limitation of the claim. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claim 1, Applicants assert that Claim 22 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 22.

Claim 23

The Office Action rejected Claim 23 for the reasons articulated for the rejection of Claims 1-22, and further stated that *Jain, et al.*, discloses identifying synonyms. Applicants traverse this rejection and characterization of the disclosure of *Jain, et al.* For the reasons discussed above with respect to the patentability of Claims 1-22, Applicants assert that Claim 23 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 23.

Claim 24

The Office Action rejected Claim 24 for the reasons articulated for the rejection of Claim 23, and further stated that *Rivette, et al.*, discloses that the generated report is selected from the group consisting of a table of results, a draft patentability analysis, a draft infringement analysis, a draft invalidity analysis, a draft search report, and a draft written opinion. Applicants traverse this rejection and characterization of the disclosure of *Rivette, et al.* For the reasons discussed above with respect to the patentability of Claims 1-23, Applicants assert that Claim 24 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 24.

Claim 25

The Office Action rejected Claim 25 for the reasons articulated for the rejection of Claim 23. For the reasons discussed above with respect to the patentability of Claims 1-23, Applicants assert that Claim 25 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 25.

Claim 26

The Office Action rejected Claim 26 for the reasons articulated for the rejection of Claim 23. For the reasons discussed above with respect to the patentability of Claims 1-23, Applicants assert that Claim 26 is patentable over the cited references and request withdrawal of the rejection and allowance of Claim 26.

Claim 27

The Office Action stated that *Jain, et al.*, teaches all of the elements of Claim 27, except that *Jain, et al.*, did not networked processors or intellectual property searching. The Office Action further asserted that *Rivette, et al.*, teaches the steps of searching for intellectual property and that *Doyle* teaches networking processors. The Office Action stated that the motivation for the combination would be maximizing the diversity of results, verifying consistency of terminology within a document, and increasing productivity while tolerating failures. The Office Action then concluded it would have been obvious to one of skill in the art at the time the invention was made to combine the references to obtain the system of Claim 27. Applicants traverse this ground of rejection and the characterization of the disclosure of the references.

As argued above with respect to the patentability of Claim 1, Applicants note that *Jain, et al.*, is for a "Visual Dictionary" that improves the retrieval performance of a query engine in a visual information retrieval system. See Abstract. *Jain, et al.*, defines "Visual Information Retrieval (VIR)" as "systems to extract and access the content of visual media, which include images and video. Col. 1, Lines 23-26. The system of *Jain, et al.*, improves a VIR "through a dictionary-like information mapping module, termed as visual dictionary or "victionary." Col. 6, Line 66-Col. 7, Line 3.

Conversely, the system of Claim 27 is for locating potential intellectual property references, and does not concern visual information retrieval. Therefore, *Jain, et al.*, is not analogous art to Claim 27 because one of skill in the art in searching for potential intellectual property references would not look to the visual information retrieval system of *Jain, et al.*, to provide any search methodology, especially given the far different search criteria of each system. Consequently, *Jain, et al.*, is nonanalogous art under MPEP §2141.01(a) and cannot be considered as a reference available for combination under 35 U.S.C. §103.

Applicants further note that there has been shown no motivation to combine the references, *Jain, et al.*, *Rivette, et al.*, and *Doyle*, other than the motivation provided by the present application. The Office Action improperly uses the advantages of the present invention in searching for intellectual property as the motivation to combine the disparate references of a visual image searching system of *Jain, et al.*, the system for analyzing documents containing patent applications of *Rivette, et al.*, and the distributed computation system of networked computers of *Doyle*. It is improper to use the present application as the template to combine the references, and accordingly, this ground of rejection must fail.

Finally, the suggested combination does not disclose all elements of amended Claim 27. Under section 103, the suggested combination must teach or suggest all of the claim limitations. MPEP §2143. Here, the suggested combination does not disclose, at least, the step of expanding the one or more search terms to create a search data set. Nowhere in any cited reference is disclosed the methodology or manner of expanding terms based upon relevance to intellectual property. The assertion in the

Office Action that *Jain, et al.*, in Figs. 4, 8-10C, discloses this step in conjunction with *Rivette, et al.*, is incorrect—all of the cited Figures (and *Jain, et al.*, itself) describes visual query parsing, and the system of *Rivette, et al.*, only concerns the development and maintenance of documents the require term consistency. Col. 2, Lines 18-30, with a patent as an example. *Rivette, et al.*, does not disclose or suggest the searching of external documents with one or more expanded search phrases. Therefore, as the suggested combination does not teach or disclose all limitations of Claim 27, this ground of rejection must fail and Applicants request withdrawal of the rejection and allowance of the claim.

In sum, the suggested combination of references cannot be used to reject Claim 27 under 35 U.S.C. §103. The suggest combination of references includes nonanalogous art, lacks proper motivation for combination, and does not disclose all elements of the rejected claim. Applicants respectfully request removal of this rejection and allowance of Claim 27.

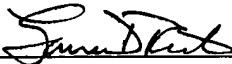
Prior Art Made of Record

Applicants have reviewed the prior art made of record in the Office Action, which is considered pertinent to Applicant's disclosure but not relied upon to reject any claim. Applicants agree with the Examiner that the references are generally indicative of the related art to the present invention, but do not singly or in combination anticipate or render obvious any claim of the present application.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1-27, as amended, are in condition for allowance and notification to that effect is earnestly solicited. If necessary, the Examiner is invited to telephone Applicant's attorney (404-521-3939) to facilitate prosecution of this application.

Respectfully submitted,
Kerven, et al.


Lance D. Reich
Reg. No. 42,097

Date 27 May 2004

1420 Peachtree Street NE, Suite 800
Atlanta, Georgia 30309-3053
Telephone: (404) 521-3939
Facsimile: (404) 581-8330

CERTIFICATE UNDER 37 CFR 1.8

The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria VA 22313-1450, on this 27th day of May, 2004.

Lance D. Reich



Changes

FIG. 2C

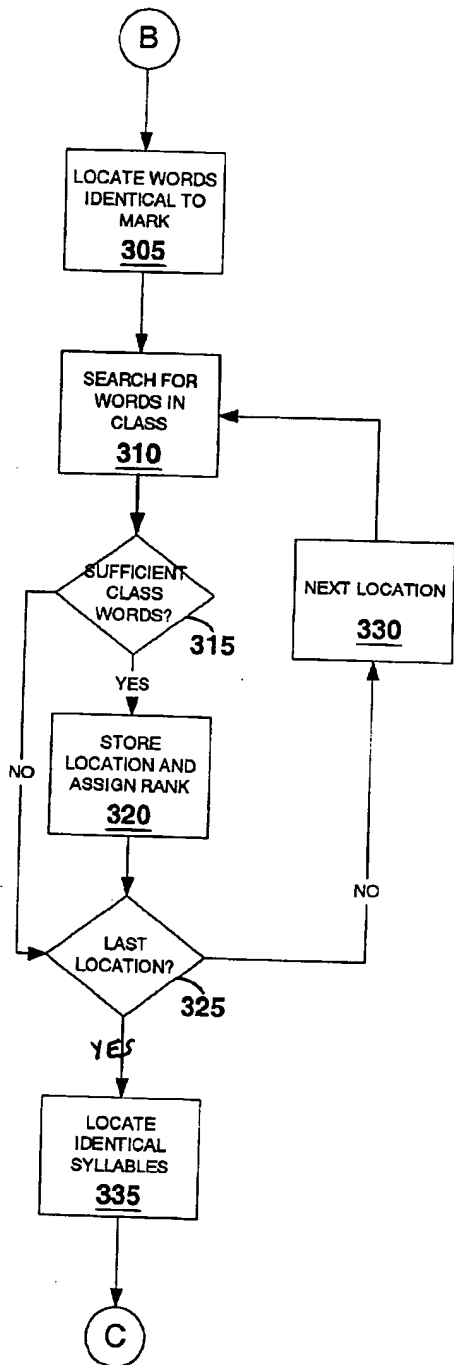


FIG. 2D

